

REMARKS

In response to the Office Action mailed October 27, 2010, Applicants provide the following remarks. Claims 21-30 stand rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Claims 1-30 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 7,568,152 to Wason et al. (hereinafter the "Wason reference") in view of U.S. Patent No. 6,535,871 to Romansky et al. (hereinafter the "Romansky reference"). Reconsideration of claims 1-30 in view of the amendments above and remarks below is respectfully requested.

By way of this amendment, Applicants have made a diligent effort to place this application in condition for allowance. However, should there remain any outstanding issues, the Examiner is invited to telephone the undersigned at (312) 577-7000 so that such issues may be resolved as expeditiously as possible.

Amendments to the Claims

Claims 21-30 have been amended to recite a "non-transitory computer readable medium having instructions stored thereon . . ." As noted below, Applicants submit that this amendment addresses the objection to non-statutory subject matter.

Claim Rejections - 35 U.S.C. §101

Claims 21-30 stand rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. While the Applicants disagree with such a characterization, the claims have nonetheless been amended to recite a non-transitory computer-readable medium in an effort to expedite prosecution. Applicants believe that the amended claims address the Examiner's concerns with regard to non-statutory subject matter and request that this rejection be withdrawn.

Claim Rejections - 35 U.S.C. §103

Claims 1-30 are rejected under 35 U.S.C. §103(a) as being unpatentable over the Wason reference in view of the Romansky reference.

The Wason reference is directed to text file processing in a computer application where the text files are used to communicate between applications or

between an application and an end user. (See Col. 1, lines 26-29). Contrary to the contention in the Office Action, however, Wason does not disclose a method for distributing secure digital content that can be indexed by third party search engines as claimed in Claim 1. (See Office Action, pg. 3, para. 4, lines 3-4; Wason, Col. 1, line 54 to Col. 2, line 33). Instead, Wason is directed to "describ[ing] and program[ing] for the structure of a text file," "mapping of data between the text file and the application," and "describing the flow of control needed to process the file." (Col. 2, lines 48-55).

The Wason reference fails to teach generating a text stream from the digital content by stripping all graphic information and punctuation from the digital content, as recited by claim 1. The Office Action contends that the Wason reference teaches stripping all graphic information and punctuation from the digital content by teaching the use of fragments of text (templates) as overlays for parsing incoming files. (Office Action, pg. 4, lines 1-3). Additional portions of Wason cited in the Office Action disclose that the "template is a literal image of the text fragment it processes, so it is possible to create the templates from the samples of the text file." (Office Action, pg. 4, lines 1-3 citing Wason Col. 2, line 67 to Col. 3, line 2). Finally, the Office Action cites to lines 35 to 67 of column 11, which states, in part:

The interface file is presented in a text area which allows editing. This can be useful when the file that is sent to be processed has header and trailer records which are not needed as it is being processed. They can be stripped off manually before the interface is processed.

(Col. 11, lines 37-41). Teaching manual editing of the text and the stripping of headers and trailers, however, cannot be considered as teaching stripping all graphic information and punctuation from the digital content. Thus, the Wason reference fails to disclose "generating a text stream from the digital content by stripping all graphic information and punctuation from the digital content" as recited in claim 1.

In addition, the Wason reference fails to disclose fragmenting the text stream into multi-word phrases that are each contained in the digital content, as recited by claim 1. While the Office Action cites to portions of the Wason reference that discuss fragments (i.e., "templates are fragments of the text that include the literals for the output text stream" Col. 4, lines 16-17), these portions of Wason merely disclose fragments of text or breaking up text into lines, which is fundamentally different from

"fragmenting the text stream into multi-word phrases that are each contained in the digital content," as recited in Claim 1. Thus, Wason fails to teach such a limitation.

The Wason reference is also cited as disclosing "making the scrambled document available to third party search engines to permit indexing of the scrambled document that will result in an index that is comparable to an index that would result if the third party search engine indexed the digital content" as recited in claim 1. Nothing in the Wason reference, however, discloses or teaches any sort of scrambled document, let alone making such a scrambled document available to third party search engines. Furthermore, the Wason reference completely lacks any disclosure of indexing. The Office Action cites to col. 5, lines 20-60; col. 6, lines 1-67; col. 12, lines 30-50; and col. 14-67 as providing disclosure of this element; however, nothing in the cited portions of the reference discloses anything related to third party search engines or indexing of scrambled content. For example, the first cited section (col. 5, lines 20-60) is directed to "templates that support parsing of the input file and mapping of its contents into a complex object structure suitable for update processing"; "a mechanism to extract data from the input stream"; and "a mechanism to map the structure of the input file into a complex object-structure suitable for internal processing." The second cited section (col. 6, lines 1-67) includes the entirety of column 6 and is similarly directed to the first cited section and also discloses "a flexible and easily extended formatting mechanism"; "a mechanism for input template creation and editing"; and "output text generation." The third cited section (col. 12, lines 30-50) is generally directed to "methods that process the interface file." (Col. 12, line 10). Finally, the fourth cited portion (col. 14, lines 14-67) is directed to a "memory structure defined by the passed processDictionary"; to "mov[ing] rows from the 'currentRow' dictionary to their permanent position"; and to "pass[ing] key[s] and value[s] from the currentRows dictionary." In sum, the Wason reference is silent regarding "making the scrambled document available to third party search engines" or "permit[ing] indexing of the scrambled document" as recited in claims 1, 11, and 21.

The Office Action concedes that the Wason reference fails to teach "...randomly assembly the phrases into a scrambled document such that the scrambled document contains at least nearly all of the words and at least most of the phrases as are

contained in the digital content..." as recited in claim 1. The Office Action then seeks to rely upon the Romansky reference as providing this teaching and attempts to modify Wason according to the teachings of Romansky.¹ The teachings of the Wason reference, however, cannot be fairly modified in such a manner.

The Wason reference is directed to text file processing, whereas the Romansky reference is directed to a method of searching documents. The Office Action fails to provide any reason or explanation as to why one of ordinary skill in the art would pluck these two particular references out of all those available and combine them as suggested. See, *Ex parte Whalen*, 89 U.S.P.Q.2d 1078 (BPAI 2008); *Ex parte Alexander*, 86 U.S.P.Q. 2d 1120, 1123 (BPAI 2007). The Board in *Whalen* stated:

The U.S. Supreme Court recently held that rigid and mandatory application of the "teaching-suggestion-motivation," or TSM, test is incompatible with its precedents. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 [82 USPQ2d 1385] (2007). The Court did not, however, discard the TSM test completely; it noted that its precedents show that an invention "composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *Id.*

The Court held that the TSM test must be applied flexibly, and take into account a number of factors "in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed." *Id.* at 1740-41. Despite this flexibility, however, the Court stated that "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements in the way the claimed new invention does." *Id.* "To facilitate review, this analysis should

¹ On page 5 of the Office Action, the summary of the rejection of claim 1 states "it would have been obvious for a person of ordinary skills in the art to combine the teachings of Coston-Oliver with Romansky to teach randomly assembling the phrases into a scrambled document" With respect to claim 1, the entirety of the rejection besides that one sentence, however, cites and combines Wason with Romansky, not Coston-Oliver. Therefore, the Applicants have focused their response on the references that have been particularly cited. Nonetheless, Applicants note that the Coston-Oliver reference also fails to teach the elements of claim 1. Coston-Oliver discloses a system for determining a relationship between first and second textual inputs and it does not teach generating a text stream by stripping all graphic information and punctuation from the digital content, fragmenting the text stream into multi-word phrases that are each contained in the digital content, and randomly assembling phrases. Indeed, portions of Coston-Oliver teach away from the claimed subject matter. For example, Coston-Oliver teaches parsing each text line into its constituent words, which teaches away from fragmenting the text stream into multi-word phrases. (See Col. 8, lines 3-4). In sum, even if Coston-Oliver is combined with Wason and/or Romansky, the combination does not teach the subject matter of claim 1.

be made explicit." *Id.*"

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The KSR Court noted that obviousness cannot be proven merely by showing that the elements of a claimed device were known in the prior art; it must be shown that those of ordinary skill in the art would have had some "apparent reason to combine the known elements in the fashion claimed." *Id.* at 1741.

In the same way, when the prior art teaches away from the claimed solution as presented here (FF12, FF20, FF22 and FF 24), obviousness cannot be proven merely by showing that a known composition could have been modified by routine experimentation or solely on the expectation of success; it must be shown that those of ordinary skill in the art would have had some apparent reason to modify the known composition in a way that would result in the claimed composition.

Thus, since the Office Action failed to provide any indication of why one of skill in the art would have combined these two references, a *prima facie* case of obviousness has not been shown.

Furthermore, modifying the Wason reference in the manner suggested in the Office Action fundamentally changes an operating principle of Wason. As outlined in MPEP 2143.01(VI), a proposed modification or combination CANNOT change the principle of operation of a reference. More particularly, if the proposed modification or combination of the prior art would change a principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The Wason reference specifically states that an "object of the present invention is to handle the problems of pattern matching and flow of control, in text file processing, by creating a structure of templates and macros that correspond to the structure of the text file to be processed." (Col. 1, lines 59-62). The Wason reference, therefore, requires that the text be handled in *structured* templates, which is completely antithetical to *random* assembly as a random presentation will work directly in opposition to Wason's extolled structured approach. The Wason reference does not merely suggest that structured processing is desirable but in fact highlights structured processing as an object of the invention. Thus, if the Romansky reference does teach randomly assembling phrases into a scrambled

document such that the scrambled document contains at least nearly all of the words and at least most of the phrases as are contained in the digital content, any fair combination of the Romansky and Wason references is nevertheless insufficient to render the claims obvious.

Furthermore, even if it is assumed *arguendo* that the Wason and Romansky references are combined as suggested by the Office Action, the resulting combination still fails to disclose, teach, or otherwise suggest the claimed subject matter. Specifically, the Romansky reference fails to teach “randomly assembling the phrases into a scrambled document such that the scrambled documents contains at least all of the words and at least most of the phrases as are contained in the digital content...” as recited in claim 1. The Romansky reference instead merely teaches “[o]ne way to conceal the relationship or combination of certain key words is randomizing the searchable synchronized index of key words.” (Col. 2, lines 35-38). The Romansky reference also discloses that “[t]he publisher of the document is also given the ability to change the order or relationship of some key words from the searchable synchronized index that may reveal sensitive information or information the publisher does not want to disclose.” (Col. 2, lines 25-29). Thus, the Romansky reference only teaches randomizing the *index* of key words and manually changing the order of some words. Nothing in the Romansky reference teaches “randomly assembling phrases into a scrambled document such that the scrambled document contains at least nearly all of the words and at least most of the phrases as are contained in the digital content” Indeed, the Romansky reference teaches away from this subject matter by teaching manually reordering words and randomizing only the index of key words, which by definition does not contain nearly all of the words and most of the phrases of the digital content.

For at least the reasons discussed above, the Wason and Romansky references fail to disclose, teach, or otherwise suggest each and every element of independent claim 1 and, therefore, do not render claim 1 and claims 2-10 dependent therefrom obvious. Therefore, Applicants respectfully assert that the rejection is overcome and should be withdrawn.

Turning now to independent claim 11, an apparatus for distributing secure

digital content that can be indexed by third party search engines is recited. Further, claim 11 recites, "a stripper that generates a text stream from the digital content by stripping all graphic information and punctuation from the digital content; means for fragmenting the text stream into multi-word phrases that are each contained in the digital content; a stream assembler that randomly assembles the phrases into a scrambled document such that the scrambled document contains at least nearly all of the words and at least most of the phrases as are contained in the digital content; and means for making the scrambled document available to third party search engines to permit indexing of the scrambled document that will result in an index that is comparable to an index that would result if the third party search engine indexed the digital content."

The Office Action cites to the same portions of the Wason and Romansky references discussed above. As already noted, these references do not teach a stripper that strips all graphic information and punctuation from the digital content; means for fragmenting the text stream into multi-word phrases, a stream assembler that randomly assembles the phrases, and a means for making the scrambled document available to third party search engines. For at least the above reasons, the Wason and Romansky references fail to disclose, teach, or otherwise suggest each and every element of independent claim 11 and, therefore, do not render claim 11 or claims 12-20 dependent therefrom obvious. Therefore, Applicants respectfully assert that the rejection is overcome and should be withdrawn.

Independent claim 21, as amended, recites a non-transitory computer-readable medium having instructions stored thereon. The Office Action cites to the portions of the Wason and Romansky references discussed above. Again, these references do not teach instructions for generating a text stream from the digital content by stripping all graphic information and punctuation from the digital content; instructions for fragmenting the text stream into multi-word phrases that are each contained in the digital content; instructions for randomly assembling the phrases into a scrambled document such that the scrambled document contains at least nearly all of the words and at least most of the phrases as are contained in the digital content; and instructions for making the scrambled document available to third party search engines to permit indexing of the scrambled document that will result in an index that is

comparable to an index that would result if the third party search engine indexed the digital content. For at least the above reasons, the Wason and Romansky references fail to disclose, teach or otherwise each and every element of claim 21 and, therefore, do not render claim 21 or claims 22-30 dependent therefrom obvious. Therefore, Applicants respectfully assert that the rejection is overcome and should be withdrawn.

CONCLUSION

Based on the foregoing, reconsideration and allowance of claims 1-30 are respectfully requested. The Commissioner is hereby authorized to charge any additional fees which may be required in this application to Deposit Account No. 06-1135.

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